



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/070,699	04/30/98	DICKENSHEETS	D A-62591-3/AJ

MM11/0202  
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EXAMINER

PHAN, J

ART UNIT PAPER NUMBER

2872

DATE MAILED: 02/02/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/070,699**

Applicant(s)  
**Dickensheets et al**

Examiner  
**JAMES PHAN**

Group Art Unit  
**2872**



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire zero month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 27-43 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 27-43 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2872

***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 28-29 and 36-40, drawn to a beam steering apparatus, classified in class 359, subclass 198.
  - II. Claim 30, drawn to a laser printer engine, classified in class 355, subclass 18.
  - III. Claim 31, drawn to an optical storage head, classified in class 369, subclass 44.14.
  - IV. Claim 32, drawn to a bar rastering projector, classified in class 353, subclass 98.
  - V. Claim 33, drawn to a laser plotter, classified in class 347, subclass 260.
  - VI. Claim 34, drawn to a laser marking writing tool, classified in class 347, subclass 110.
  - VII. Claim 35, drawn to an optical switch, classified in class 385, subclass 18.
  - VIII. Claim 41, drawn to a steering apparatus having a deformable mirror, classified in class 359, subclass 224.
  - IX. Claim 35, drawn to an apparatus for viewing a medium, classified in class 348, subclass 359.

Claim 27 will be examined along with any of the inventions I-VIII, if elected.

2. The inventions are distinct, each from the other because of the following reasons:

Each of the inventions I-IX contains a patentably distinct subject matter which is not required in the other invention.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the fields of search are not coextensive (see below), restriction for examination purposes as indicated is proper.

Group I requires at least a search in class 359, subclass 198, while the other Groups do not.

Group II requires at least a search in class 355, subclass 18, while the other Groups do not.

Group III requires at least a search in class 369, subclass 44.14, while the other Groups do not.

Group IV requires at least a search in class 353, subclass 98, while the other Groups do not.

Group V requires at least a search in class 347, subclass 260, while the other Groups do not.

Group VI requires at least a search in class 347, subclass 110, while the other Groups do not.

Group VII requires at least a search in class 385, subclass 18, while the other Groups do not.

Group VIII requires at least a search in class 359, subclass 224, while the other Groups do not.

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Group IX requires at least a search in class 348, subclass 359, while the other Groups do not.

If invention I is elected, the following election of species is required.

Invention I contains claims directed to the following patentably distinct species of the claimed invention: (1) a beam steering apparatus wherein the constraint means is a gimbaled hinge means; and (2) a beam steering apparatus wherein the constraint means is a compliant medium means.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 27 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to

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be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.


3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Phan whose telephone number is (703) 308-4810. The examiner can normally be reached on M-F from 9:30 to 6:00. The fax phone number for this Group is (703) 308-7722.

Phan, J.

Jan. 29, 1999

  
James Phan  
Primary Examiner